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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,449	01/24/2001	Ruediger Guenter Kreuter	2968.204USU1	2397

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MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

ST CYR, DANIEL

ART UNIT PAPER NUMBER

2876

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,449

Applicant(s)

KREUTER ET AL.

Examiner

Daniel St.Cyr

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6,8,9,12,14-25 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-25 is/are rejected.
- 7) ☒ Claim(s) 1,2,4,6,8,9,12,14-16 and 28-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/22/03 has been entered.

Claim Objections

2. Claims 1, 20, and 28 are objected to because of the following informalities:

Claim 1, lines 10-11, "being capable of performing" is not a positive limitation, it should be changed to --performs--.

Claim 20, line 3, change "a" to --the--.

Claim 28, line 11, change "the" to --a--.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person ~~having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the~~ manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 17-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devrient, EP Patent No. 364,730, cited by the applicant.

Devrient discloses a production of book form identification comprising: an apparatus and methods for producing an identification document 1 (a passport) having data sheets 3-6; a personalized system for personalizing the passport having an input means with a stack of passports 1, means A for leafing the sheet; and laser printing means S4' for printing information onto the sheets; (see figures 3 and 4).

Devrient discloses that the laser station S4' may be separately comprises a laser device and a matrix printer, but fails to specifically disclose that each device (laser and printer matrix) has a leafing device.

However, since having two different printing means within the personalized system would require additional means for turning the appropriate sheet to be personalized by either the laser or the matrix printer.

It would have been obvious for a person of ordinary skill in the art at the time the invention was made to include an additional leafing means into the system to leaf the appropriate sheet of the document. Such modification would facilitate the personalizing aspect of the passports wherein the laser device would be designated to encode information onto the laminated sheet of the document and matrix printer for printing information onto the non-laminated sheet of

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the document, as required by the manufacturing process. Furthermore, having multiple personalizing stations would expedite and make the personalization process more effective.

Therefore, it would have been an obvious extension as taught by Devrient.

6. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Devrient in view of Atalla, US Patent No. 4,347,529.

Devrient fails to disclose of fairly suggests the document includes an integrated circuit chip.

Atalla discloses a multilevel security apparatus and method comprising a passport 9 having an integrated circuit attached thereon (see col. 7, lines 15).

In view of Atalla's teachings, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the system of Devrient to incorporate an integrated circuit system having integrated circuits into the passports wherein integrated module would be used to store identification information into the circuits. Such modification would make the system more reliable by providing more additional storage so that more positive information could be stored to effectively identify individuals carrying the passports, which would make the system more desirable. Therefore, it would have been an obvious extension as taught by Devrient.

Allowable Subject Matter

7. Claims 1, 2, 4, 6, 8, 9, 12, 14-16, and 28 would be allowable if rewritten or amended to overcome the objection set forth in this Office action.

8. The following is a statement of reasons for the indication of allowable subject matter:

Although the prior art of record teaches a system and method for leafing pages of a document so

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as to personalize the document, which includes a leafing device, a personalized device, etc., and suggests that additional device could be employ so that different type of personalization could be performed, the prior art of record fails to disclose the specific details of the components to incorporate additional leafing and personalized device, including arranging the personalization mechanism and the leafing device in a way that each of the personalization mechanism that performs a personalization function is different from that of a preceding one. These limitations in conjunction with other limitations in the claims were not shown by the prior art of record.

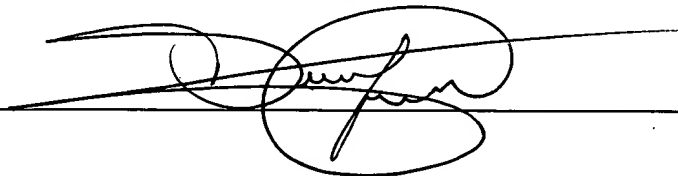
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Daniel St.Cyr
Primary Examiner
Art Unit 2876

DS
September 4, 2003

A handwritten signature in black ink, appearing to read 'Daniel St.Cyr', is written over a horizontal line. The signature is stylized with loops and a long horizontal stroke extending to the right.